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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,183

Applicant(s)

SPEASL ET AL.

Examiner

GELEK TOPGYAL

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/6/2009 have been fully considered but they are not persuasive.
2. In re pages 23-27, the applicants present numerous arguments regarding the rejection based on Christopher and Kaltenecker with reference to claim 1. A new 103 rejection is discussed in the art rejection below including a new reference, however, some of the arguments pertaining to Christopher and Kaltenecker will henceforth be addressed. Firstly, the applicants argue regarding the portability and the size limitations of the claim, the examiner provides no teaching of prior art besides the use of In re Rose. Furthermore, it is argued that the examiner's position that the "claimed portability and size limitations do not affect the "functionality" of the device" is argued. This is supported by the reciting the case of *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, wherein "no limitation in a claim is any more or less "core" than any other limitation.
3. In response, the examiner respectfully disagrees. In the rejection below, it will be discussed that *In re Rose* is relied upon to meet the limitations of "size limitations" and "portability" is met by the introduction of Lee (US 6,684,089) into the rejection of claim 1. Lee (US 6,684,089) teaches of replacing the conventional desktop personal computer with the functionality of Handheld PC or a PDA that can perform the same functions of a conventional desktop personal computer. In the rejection below the PC 410 of Christopher is expanded upon by Lee, wherein a conventional desktop PC can be replaced by a Handheld PC or a PDA performing the same functions (Lee, col. 1, lines

11-36) for the provided benefit of it being easy to carry. Therefore, the proposed addition of Lee into Christopher and Kaltenecker meets the claimed function of "portability".

However, with regards to the arguments regarding the "size limitations" of the claim, the examiner respectfully disagrees. The examiner has taken into consideration the discussions in pages 24-26 regarding *Gore v. Garlock* and *Ex parte Dunbar*. In *Gore v. Garlock* the determination is that no limitation in a claim is more or less "core" than any other limitation, however the examiner believes that it still doesn't overcome the recitation in MPEP Chapter 2100. The proposed combination of Christopher, Kaltenecker and Lee below perform the same function as that of the claims provided with clear motivation that a desktop computer can be made portable and smaller (to fit in certain dimensions). However, the examiner still contends that changes in size limitations are just mere *design choices*, and are not patentable on its own. Therefore, the examiner still believes *In re Rose* is capable of meeting the claimed size limitations of the portable memory device. The evidentiary proof of being able to make a desktop PC smaller is given by Lee in col. 1, lines 11-36, where a pocket PC or PDA is small enough to fit in the palm of a hand or in a shirt pocket is clearly realizable. The citing of *In re Rose* (taken alone or in combination with the evidentiary teachings of Lee) provides a *prima facie* case of obviousness since it was very well known to reduce the size of desktop PC to make it fit into a particular dimension.

Regarding discussion of *Ex parte Dunbar* and *Sponnoble* in pages 26-27, the examiner provides a new ground of rejection with clear motivation to provide a *prima*

facie case of obviousness for making the PC portable and the PC's size limitations. Furthermore, the applicants seem to rely heavily on paragraphs 0005, 008, 0009, 0033 of the instant specification. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "can be held in a user's hand", "shirt pocket") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. In re page 28, the applicants argue with respect to dependent claims 3, 4, 9, 14 and 18.
5. In response the examiner respectfully disagrees. Regarding claim 3, the examiner's position of In re Rose meeting the size limitations are applicable here as well. Regarding claim 4, the applicants have provided a piecemeal analysis as Christopher is not relied to teach the ability to "determine a second image file format suitable for a second one of the hosts". In the first paragraph of page 7 of the Final Rejection mailed 1/5/09, Kaltenecker is relied upon to teach that limitation. Christopher's system has the capability to "communicate the image to the second host". Therefore, the proposed combination of Christopher and Kaltenecker are relied upon to teach those two limitations. Regarding claim 9, the examiner has provided a new ground of rejection. Regarding claim 14, Christopher's "other devices" are relied upon to meet the claimed host, and not the memory card that lies within the "other device". The communication path relied upon can be between the PC 410 and digital cameras (col.

1, line 32). Regarding claim 18, the applicants argue that the PDA of Christopher does not include a slot for receiving and holding a plurality of memory devices simultaneously. In response, the examiner had cited Handheld computer *with the* cradle. The cradle has slots for SD card and Multimedia Card.

6. In re page 29, the applicants argue with respect to dependent claims 22, 33, and 35.

7. In response, the examiner respectfully disagrees. Claim 22 is rejected for the same reasons as discussed in paragraph 5 above regarding claim 18. Regarding claims 33 and 35, it is not understood wherein page 11 of the Final Rejection dated 1/5/2009 the examiner identifying PDA as a host. Christopher clearly teaches of the ability to import video files from a digital device connected to the PC 410 (see col. 3, lines 46-51).

8. In re pages 30, the applicants argue the same points for claim 45 as presented for claim 1 above. Furthermore, applicants present that the Office action does not recite any motivation or any other reasons why it would have been obvious to modify Christopher's desktop computer system to be physically smaller than his PDA. In response, as discussed above in paragraph 3, the addition of art of Lee (US 6,684,089) provides for reasons to modify Christopher's desktop so that its smaller. However, as discussed in claim 1 above regarding the "size limitations" that have been presented, In re Rose and MPEP Chapter 2100 clearly states that changes in size does not make a claim patentable over prior art that performs the same functions.

9. In re pages, 31-34, applicants argue that dependent claims 46-73, 75-92 and 94-103 are also patentable for the same reasons as in discussion A regarding claim 1. In response, the applicants are directed to the discussion in paragraph 3 above.
10. In re pages 31-33, the applicants argue with respect to dependent claims 74 and 93 that the second image file format is determined "in dependence upon the second host itself" and that its not taught by Kaltenecker. In response, the examiner respectfully disagrees. Although Kaltenecker uses format rules, the format rules are set so that a second format can be achieved by converting a first format to a second format. The second format being playable in the second host makes the determination dependent on the second one of the hosts.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-8, 10-31, 38, 40, 42, 45-67, 74-85, 89, 92-104** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277) and further in view of Lee (US 6,684,089).
13. **Regarding claims 1-4, 45, 49, 74-77, 92-98 and 100-103**, Christopher et al. teaches a portable memory device comprising a substrate supporting:
- a memory (Fig. 4, Memory 414 and Storage Device 418);

a display (Fig. 4, PC 410);

a communications interface for establishing a user-severable communication link (Fig. 4, Communication link via cradle 420) between the memory device and a plurality of different hosts (Fig. 4, Handheld computer 440, SD card and Multimedia card 432 and other devices connectable to the PC via bus 412) at different times, at least one of the hosts being physically larger than the memory device (specifying a particular size/range of the hosts as compared to the memory device does not make the specified limitation patentably distinct. See *In re Rose*, 105 USPQ 237 (CCPA 1955), wherein "differences in degree and/or size and [are] not patentable distinctions" and that "the size of the article under consideration is not ordinarily a matter of invention");

a mounting system for rigidly attaching the memory device to each of the host at different times (Fig. 4, Cradle for coupling SD card, Multimedia card and Handheld computer 440 and via bus 412 (see col. 3, lines 5-10)); and

a controller (Fig. 4, Processor 416) operable in response to user input to;

store in the memory an image received from a first one of the hosts via the communication link while the portable device is in communication with the first host (col. 3, lines 52-61 teaches of transferring images taken to/from any of the devices SD card 430, Multimedia card 432, Handheld computer 440 and any other devices via system bus 412 (see col. 3, lines 5-10) to/from the PC (memory 414 and 418));

render on the display an image represented in a file in the memory at least while the portable device is not in communication with any host (Fig. 4, PC has the ability to

render any type of data stored/transferred thereon, including images, documents and video);

wherein the memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm (specifying a particular size/range of the bounding box does not make the specified limitation patentably distinct. See *In re Rose*, 105 USPQ 237 (CCPA 1955), wherein "differences in degree and/or size and [are] not patentable distinctions" and that "the size of the article under consideration is not ordinarily a matter of invention". See discussion the third part of paragraph 3 above wherein evidence of making PCs smaller is given);

and communicate the image to the second host via the communication link according to the second image file format while the portable device is in communication with the second host (col. 3, lines 52-61 teaches of transferring images taken to/from any of the devices SD card 430, Multimedia card 432, Handheld computer 440 and any other devices via system bus 412 (see col. 3, lines 5-10) to/from the PC (memory 414 and 418)).

However, the system of Christopher fails to particularly teach the feature to determine a second image file format suitable for a second one of the hosts; and

transform an image in the memory from a first image file format to a second image file format, and

that the memory device is "portable".

In an analogous art, Kaltenecker et al. teaches the feature to determine a second image file format suitable for a second one of the hosts (col. 2, lines 28-61), and

communicate the image to the second host via the communication link according to the second image file format while the portable device is in communication with the second host (col. 2, lines 28-61); and

transform an image in the memory from a first image file format to a second image file format (col. 2, lines 28-61);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to determine a second format suitable for the second host and to transform the image according to the second format as taught by Kaltenecker et al. into the system of Christopher to allow for the second host to be able to view the image of the first format.

However, the proposed combination of Christopher and Kaltenecker fails to teach wherein the memory device (PC of Christopher) is portable.

In an analogous art, Lee teaches in col. 1, lines 11-36 of replacing the conventional desktop personal computer with the functionality of Handheld PC or a PDA. The motivation lies in that that Handheld PC or PDA performs the functions of a conventional desktop personal computer; however a Handheld PC or PDA is easy to carry.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to replace the functions of a Desktop PC with the use of a Handheld PC or PDA as taught by Lee into the proposed combination of Christopher and Kaltenecker so that the "PC" is easier to carry.

As to claim 74 and 93, see paragraph 10 above for discussion.

As to claim 104, col. 3, lines 17-27 teaches of "button 128 which may be utilized for initializing synchronization or transfer of data between cradle/handheld computer 130 and computer 110.

Claims 5-8 are rejected for the same reasons as discussed in claim 1 above, and further the user operating the PC 410, a user controls the PC 410 with a keyboard, mouse or touchpad to implement the functions as discussed in claims 5-9 (see col. 4, lines 25-55).

Regarding claims 10 and 11, Christopher teaches the a PC 410 which has a display, however is silent to teach wherein the group consists of an LCD display, polymer with photoresist properties, a plasma display and an OLED display and a cholesteric display. It is noted that these display types are well known and old in the art, and therefore Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the different types of displays to increase compatibility with different types of display systems.

Claim 12 is rejected for the same reasons as discussed in claim 1 above, wherein col. 3, lines 5-10 teaches the communication link.

Regarding claim 13, Christopher teaches the claimed wherein the hosts could be a PDA (met by handheld computer 10), a cellular telephone (col. 1, line 32), a TIVO device (col. 1, line 32) and a digital camera (col. 3, lines 24-26).

Regarding claim 14, Christopher teaches in col. 3, lines 24-26 of other storage devices that uses a memory card.

Regarding claims 15-19, 22 and 23, Christopher's secondary device (Figure, 4, Handheld computer 430 with the cradle 420) meets the claimed cartridge/slot for receiving the multiple memory devices with the systems ability to connect to the PC 410 via system bus 412. The connection, e.g. a USB interface has two connectors that couple/fasten/mate the two devices that are to be connected via the connecting interface.

Regarding claims 20-21, Christopher teaches the claimed as discussed in col. 4, lines 25-55

Regarding claims 24-26, Christopher teaches the claimed in the PC 410, wherein the memory, display, communications interface and the controller are all attached to the substrate (PC's inherent motherboard meets the claimed substrate, which can vary in structure, i.e. flexible/rigid).

Regarding claims 27-31, Christopher teaches a processor (Fig. 4, processor 416), a program memory (Fig. 4, Memory 414) separate from the first memory ((Fig. 4, Storage device 418)).

Regarding claims 38 and 40, Christopher teaches the ability to import videos from a digital device connected to the PC 410 (see col. 3, lines 46-51) and the PC 410 has the ability to review the video files,

Claim 42 is rejected for the same reasons as discussed in claims 10 and 11 above, and furthermore, the system of Christopher teaches a Keyboard/Mouse which meets the claimed button/receiver/switch for a remote control device.

Claims 46-48 are rejected for the same reasons as discussed in claims 15-19, 22 and 23 above.

Claims 50-67 are rejected for the same reasons as discussed above in claims 5-9, 12, 14, 17-22, 24, 25, 27, 28 and 31, respectively.

Claims 78-85 are rejected for the same reasons as discussed above in claims 7, 8, 12, 13, 17, 18, 22 and 24, respectively.

Claim 89 is rejected for the same reasons as discussed in claim 38 above.

Claim 99 is rejected for the same reasons as discussed in claims 1 and claims 15-199, 22 and 23 above.

14. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277), further in view of Lee (US 6,684,089), and further in view of Ando et al. (US 7,525,571).

15. **Regarding claim 9**, the proposed combination of Christopher, Kaltenecker et al. and Lee teaches the claimed as discussed in claim 1 above, however fails to particularly teach wherein the controller when operated to render on the display an image from the first host while the memory device is in communication with the first host, the image bypasses the memory.

In an analogous art, Ando et al. teaches in Fig. 18 and col. 18, lines 5-15 of the basic ability to display an image on a first device. The image displayed on the first device being only stored in the second device. The storage of the image on the first device only takes place when the transfer of the images is completed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to display an image from the first host on the memory device (first device and second device in Ando et al.) as taught by Ando et al. into the proposed combination of Christopher, Kaltenecker et al. and Lee so that a user is aware of the content of the images (by way of the previewing ability of Ando et al.) being transferred.

16. **Claims 32, 34, 41, 68, 69, 72, 86 and 90** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277), further in view of Lee (US 6,684,089), and further in view of Jones et al. (US 2002/0118949).

17. **Regarding claims 32, 34 and 41**, the proposed combination of Christopher, Kaltenecker et al. and Lee teaches the claimed as discussed in claim 1 above, and teaches the ability to store images transferred from a digital camera (see claims 1 and 14 above), however fails to teach wherein the sequential images are rendered on the display as a movie. In an analogous art, Jones et al. teaches the claimed in Fig. 3, steps 301-315 teaches wherein still images can be compiled into MPEG1 stream and is stored locally on the computer first before writing to the VCD. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings on Jones et al. into the proposed combination of Christopher, Kaltenecker et al. and Lee to increase compatibility of systems that aren't able to reproduce a set of images.

Claims 68, 69 and 72 are rejected for the same reasons as discussed above in claims 32, 34 and 41, respectively.

Claims 86 and 90 are rejected for the same reasons as discussed above in claims 32 and 41, respectively.

18. **Claims 33, 35, 36, 70 and 87** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277), further in view of Lee (US 6,684,089), and further in view of Jeong et al. (US 6,690,878).

19. **Regarding claims 33, 35 and 36**, the proposed combination of Christopher, Kaltenecker et al. and Lee teaches the claimed as discussed in claim 1 above, and teaches the ability to import videos from a digital device connected to the PC 410 (see col. 3, lines 46-51) and the PC 410 has the ability to review the video files, however, the proposed combination of Christopher and Kaltenecker et al. fails to particularly teach the feature to capture an image frame of the video file and store it as an image file in the first memory.

In an analogous art, Jeong et al. teaches in cols. 2-3 of the ability to capture a still image from a moving image stream and to input/generate file management function (image index information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to capture a still image and to generate file

management functions so that systems can use a captured still image for representing a larger movie file, especially in large databases/archives.

Claim 70 is rejected for the same reasons as discussed in claim 35 above.

Claim 87 is rejected for the same reasons as discussed in claim 35 above.

20. **Claims 37, 39, 43, 71 and 88** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277), further in view of Lee (US 6,684,089) and further in view of Torres et al. (US 6,738,075).

21. **Regarding claims 37, 39 and 43**, the proposed combination of Christopher, Kaltenecker et al. and Lee teaches the claimed as discussed in claim 1 above, including the feature for a digital camera (see above claim 14) which allows for still images to be taken, however fails to particularly teach wherein audio information (sound/associated sounds) can be associated with still images as they are rendered for display.

In an analogous art, Torres et al. (US 6,738,075) teaches in Figures 4-8, wherein audio messages (meeting the claimed "sound"/"associated sounds") can be recorded that is associated with a still image and to play the audio messages during playback of the said still images.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to store and reproduce an associated audio clip as taught in Torres et al. into the proposed combination of Christopher, Kaltenecker et al. and Lee in order to improve the ability to identify the still images taken with audible descriptions.

Claim 71 is rejected for the same reasons as discussed in claim 37 above.

Claim 88 is rejected for the same reasons as discussed in claim 37 above.

22. **Claim 44, 73 and 91** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277), further in view of Lee (US 6,684,089) and further in view of Falcon (US 7,222,207).

Regarding claim 44, the proposed combination of Christopher, Kaltenecker et al. and Lee teaches the claimed as discussed in claim 1 above, however fails to particularly teach the feature to determine a geolocation of the portable memory device; and render on the display a map which includes a visible marking of the geolocation.

In an analogous art, Falcon teaches in col. 9, lines 24-35 the ability to determine the current location of a portable computing device and to display that location on a map.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to display a map with the current location so that users can utilize a map for navigational purposes.

Claim 73 is rejected for the same reasons as discussed in claim 44 above.

Claim 91 is rejected for the same reasons as discussed in claim 44 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gelek Topgyal/
Examiner, Art Unit 2621

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